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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,439	08/02/2001	Gurbinder Singh Kalsi	60130-1179/00MRA0557	6121

26096 7590 08/26/2004

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EXAMINER

MCANULTY, TIMOTHY P

ART UNIT PAPER NUMBER

3682

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/921,439

Applicant(s)

KALSI ET AL.

Examiner

Timothy P McAnulty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-26 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1,3,9, and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application EP 0 684 356 A1.

EP 0 684 356 A1 discloses in figures 14-16, an actuator comprising a chassis; a rotatable gear 5 driveable by a motor 3; an output element 7; a resilient drive transfer device 19; and a resilient stop member 8 pivotally connected to the chassis; said stop member having a forward stop arm and a reverse stop arm.

Regarding claim 1, the drive transfer device is inherently operably disconnectable from the output lever.

Regarding claim 9, the drive transfer device is inherently operably reconnectable with the output lever.

Regarding claim 18, the stop member is inherently resiliently movable by changing of an angle between the forward stop arm and the reverse stop arm.

3. Claims 14 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dilger et al.

Dilger et al. discloses in figures 1-2 and 6 an actuator comprising a chassis; a drive gear 21 rotatable between a first position and a second position; an output element 11 movable between a first output position and a second output position; a transfer device 32 disconnectable from said output member; and a stop device having a first member 19 and a second member 35.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-7, 9,10,12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dilger et al. in view of European Patent Application 0 684 356 A1.

Dilger et al. discloses the basic apparatus as previously cited but does not disclose said output member rotatable about the same axis as said drive gear. However, EP 0 684 356 A1 teaches in figures 14-16, an actuator comprising, *inter alia*, a chassis; a rotatable gear 5; an output element 7; and a resilient drive transfer device 19; wherein said rotatable gear and said output element rotate about the same axis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Dilger et al. in view of the teachings of EP 0 684 356 A1 to provide said drive gear and said output element to rotate about the same axis to provide a more compact drive train thus requiring less space for said actuator.

Regarding claims 5-7, Dilger et al. further discloses said transfer device 32 resiliently biased in a first direction by a first resilient means 33; a first ramp 31 and a second ramp (not referenced).

Regarding claim 18, the stop member is inherently resiliently movable by changing of an angle between the forward stop arm and the reverse stop arm.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dilger et al. in view of Yamada.

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Dilger et al. discloses the basic apparatus as previously cited but does not disclose said drive transfer device being a pin. However, Yamada et al. teaches in figures 1,2, and 12 an actuator comprising among other things a drive transfer device pin 76 resiliently biased by a resilient member 86. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Dilger et al. in view of Yamada to provide said drive transfer device as a pin so as to increase and thus improve the mechanical connection between said drive transfer device and the output element during engagement therebetween.

***Allowable Subject Matter***

7. Claims 21-26 are allowed.
8. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments filed 12 May 2004 have been fully considered but they are not persuasive.

The transfer device of EP 0 684 356 A1 is inherently "operably disconnectable" from the output element. The cam 7 is disconnectable from the elastic member 19 even though there is an interlocking fit therebetween. Any two elements are disconnectable from one another.

Futhermore, once the cam is disconnected from the elastic member the output element will then more independently of the gear 5, i.e., after being disconnected, the interlocking fit between the

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cam and the elastic member will no longer govern the interaction therebetween; the cam and the elastic member will be disconnected.

The output member of Dilger et al. does in fact stop the motor. See lines 6-54 of column 6. The stop device of Dilger et al. turns off the motor at certain positioning of the fork 19 and the switch 35 that is connected between the housing 10 and the wheel 21. The motor is turned off in at least one of the first or second stop positions of the fork 19. See also Figure 5.

Furthermore, the motor does not continue to operate causing the device to continuously cycle between locked and unlocked positions. The arresting elements 32 further allow the turning lever 11 to be operated when the fork 19 is blocked and stationary. See lines 20-34 of column 4.

Regarding the combination of EP 0 684 356 A1 and Dilger et al., the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 USPQ (CCPA 1972); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Furthermore, there is no requirement that the modified prior art disclose a shortcoming or need for improvement. As long as one of ordinary skill in the art would be motivated by the disclosures of the references the combination is proper. Here, one of ordinary skill in the art would be motivated to make a more compact design as space saving, especially in vehicle design, is a basic design objective.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

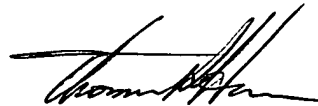
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tpm

A handwritten signature in black ink, appearing to be 'tpm' followed by a stylized flourish.A handwritten signature in black ink, appearing to be 'Thomas R. Hannon' followed by a stylized flourish.

Thomas R. Hannon  
Primary Examiner